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Paper No. 4

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**COPY MAILED**

**NOV 19 2002**

In re Application of  
Loop et al.

Application No. 10/016,653

Filed: December 5, 2002

For: DESICCANT BAG WITH ENCLOSED EAS  
TAG AND SECURITY MARKINGS

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**OFFICE OF PETITIONS**

LETTER AND NOTICE OF  
ABANDONMENT

This letter is in response to a Petition for Extension of Due Date for Filing Signed Declaration, filed August 12, 2002.

A review of the file reveals that on January 10, 2002, this Office mailed a Notice to File Missing Parts of Nonprovisional Application (hereinafter "Notice") to Petitioner which set a two (2) month, period for reply. The Notice required the filing fee, \$370; the oath or declaration and surcharge for late filing of the oath or declaration, \$65. The two-month period for reply was non-statutory, and extensions of time were available under 37 CFR 1.136(a)<sup>1</sup>.

Petitioner files the instant correspondence along with the filing fee, \$370, and surcharge for late filing of the oath or declaration, \$65. However, no oath or declaration has been filed. Instead, Petitioner requests a two (2) month extension of time in order to file the oath or declaration. Petitioner further avers that he is unable to obtain the signature of a deceased inventor.

Petitioner is advised that the maximum extendable period for reply has expired, and no further extensions of time are available. **This application has become abandoned by operation of law on August 11, 2002<sup>2</sup>.** Petitioner must revive the application.

Petitioner is further advised that, where an inventor, or the legal representative of a deceased inventor, refuses to sign the oath or declaration after having been presented with the application for review, and declaration for signing, petitioner may file a petition under 37 CFR 1.147(a) to allow the other inventor(s) to proceed with the application on behalf of himself or herself and the nonsigning legal representative of the deceased inventor.

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<sup>1</sup> Because the two (2) month period for reply was non-statutory, and extensions of time were available, petitioner was given a seven (7) month period within which to reply (2 months to reply given in the notice, and 5 months of extensions of time available under 37 CFR 1.136(a)).

<sup>2</sup> Since August 10, 2002 was a Saturday, Petitioner was given until Monday, August 12, 2002, to timely file a response to the Notice, which Petitioner complied with.

Petition under 37 CFR 1.137(b)

Applicant is strongly urged to file a petition to revive the application under 37 CFR 1.137(b), stating that the delay was unintentional. A grantable petition to revive an abandoned application under 37 CFR 1.137(b) must be accompanied by: **(1) the required reply (unless previously filed), which may met by the filing of a continuing application in a nonprovisional application abandoned for failure to prosecute, but must be the payment of the issue fee or any outstanding balance thereof in an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof;** (2) the petition fee required by 37 CFR 1.17(m), which is currently \$640.00 for a small entity and \$1280.00 for a large entity; (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and (4) a terminal disclaimer (for applications filed before June 8, 1995), (and fee as set forth in 37 CFR 1.20(d)).

In this instance, the required reply is either a fully executed oath or declaration, **or a grantable petition under 37 CFR 1.47<sup>3</sup>**. A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor.

In this instance, Petitioner must present the application and declaration to the legal representative of the deceased inventor, of his attorney, for review of the application and signing of the declaration. Should the attorney or legal representative refuse to sign the declaration after having been presented with the application and declaration, petitioner may apply to allow the other inventor(s) to proceed with the application on behalf of himself or herself and the nonsigning legal representative of the deceased inventor.

Additional requirements include an acceptable oath or declaration under 37 CFR 1.63 and 35 U.S.C. §§ 115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor.

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<sup>3</sup> 37 CFR 1.135(a) specifies that an application becomes abandoned if applicant "fails to reply" to an office action within the fixed statutory period. This failure may result either from (A) failure to reply within the statutory period, or (B) insufficiency of reply, i.e. failure to file a "complete and proper reply, as the condition of the case may require" within the statutory period (37 CFR 1.135(b)).

Regarding the oath or declaration, the Manual for Patent Examining Procedure ("MPEP"), section 409.03(a)(A) provides:

All the available joint inventors must (1) make oath or declaration on their own behalf as required by 37 CFR 1.63 or 1.75 (see MPEP § 602, § 605.01, and § 1414) and (2) make oath or declaration on behalf of the nonsigning joint inventor as required by 37 CFR 1.64. An oath or declaration signed by all the available joint inventors *with the signature block of the nonsigning inventor(s) left blank* may be treated as having been signed by all the available inventors on behalf of the nonsigning inventor(s) unless otherwise indicated. (Emphasis supplied).

MPEP 409.03(a).

A Declaration listing all inventors, signed by the available inventors with the signature block of the non-signing inventor(s) left blank, is required.

Finally, the filing of a petition under 37 CFR 1.137(b) cannot be intentionally delayed and therefore must be filed promptly. A person seeking revival due to unintentional delay can not make a statement that the delay was unintentional unless the entire delay, including the delay from the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revival under 37 CFR 1.137(b).

#### Conclusion

Petitioner must file a petition under 37 CFR 1.137(b), and as the required reply, submit either a fully executed oath or declaration, or a grantable petition under 37 CFR 1.47(a).

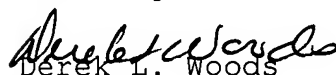
Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents  
Box DAC  
Washington, D.C. 20231

By FAX: (703) 308-6916  
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23  
2201 S. Clark Place  
Arlington, VA 22202

Telephone inquiries related to this decision may be directed to the undersigned at (703) 305-0014.



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Office of the Deputy Commissioner  
for Patent Examination Policy